OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT.

No. 14937.

UGO MONACO AND MONTECATINI SOCIETA GENERALE PER L'INDUSTRIA MINERARIA E CHIMICA ANONIMA, *Appellants*,

vs.

ROBERT C. WATSON, Commissioner of Patents, *Appellee*.

Appeal from the United States District Court for the District of Columbia.

Decided August 27, 1959.

Mr. Harry A. Toulmin, Jr., with whom *Mr. F. E. Drummond* was on the brief, for appellants.

Mr. George C. Roeming, Attorney, United States Patent Office, with whom *Mr. Clarence W. Moore*, Solicitor, United States Patent Office, was on the brief, for appellee.

Before EDGERTON, FAHY, and BURGER, *Circuit Judges*.

PER CURIAM: Appellants had been the losing parties in a Patent Office proceeding in which the board of patent interferences adjudged a different applicant, Paul H. Hoffman, to be the prior inventor. Instead of appealing to the Court of Customs and Patent Appeals, appellants elected to sue in the District Court under 35 U. S. C. § 146 to require the Commissioner to issue the patent to them. That suit is pending in the District Court and is not before us. In a second suit, appellants seek to restrain the Commissioner from issuing the patent to Hoffman while the first suit is pending. The present appeal is from a judgment for the defendant in the second suit.

The statute provides that the "question of priority of invention shall be determined by a board of patent interferences * * * and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor." 35 U. S. C. § 135. We think this means just what it says. We see nothing to suggest that applicants who, like these appellants, are adjudged *not to* be prior inventors, can require the Commissioner to withhold the patent while they sue for it under § 146.

The policy of the statute is clear. The decision of the board of patent interferences is presumably, though not conclusively, correct. If Hoffman, to whom the board awarded priority, gets the patent, he gets no more than is presumably his. To withhold the patent from him for the benefit of applicants who presumably are not entitled to it would serve no useful purpose. If the appellants win their suit under § 146 their rights will be protected even if the Commissioner has issued the patent to Hoffman in the meantime, for § 135 provides that a "final judgment adverse to a patentee * * *, shall constitute cancellation of * * * the patent * * *."

Pursuant to *In re Allen*, 145 F. 2d 936, 28 CCPA 792, the Commissioner withholds patents while appeals from the Patent Office are pending in the Court of Customs and Patent Appeals. That decision and that practice do not concern us. Appellants' suit under § 146 "is de novo and not an appeal." *Knutson v. Gallsworthy*, 82 U. S. App. D. C. 304, 314, 164 F. 2d 497, 507. "It is an application to the court to set aside the action of one of the executive departments of the government." *Morgan v. Daniels*, 153 U. S. 120, 124.

Affirmed.

BURGER, *Circuit Judge, dissenting*: Under the holding of the Court of Customs and Patent Appeals in *In re Allen*, 28 C. C. P. A. (Patents), 115 F. 2d 936 (1940), the Commissioner of Patents has *no jurisdiction* to issue a patent to a winning party in an interference proceeding during the pendency of the loser's appeal to the CCPA. It is not a matter of discretion, and so the Commissioner conceded in the District Court, although he argues to the contrary here.

For purposes of the Commissioner's interim jurisdiction I can see no difference between an appeal to the CCPA under 35 U. S. C. § 141 and a suit for review in a District Court under 35 U. S. C. § 146. Before *In re Allen* but subsequently to *Whipple v. Minor*, 115 Fed. 117 (D. Mass 1883) (relied on here by the Commissioner), the Act of 1927 had amended Rev. Stat. § 4915 (1875) so that an appeal to the CCPA or a bill in equity in the District Court were mutually exclusive remedies with identical time limitations. 44 Stat. 1336 (1927). These are provisions analogous in every material respect to present 35 U. S. C. §§ 141 and 146. Thus, although there have historically been differences between these two methods for reviewing a decision in an interference proceeding, the two routes are now procedurally the same and should therefore have the same effect upon the jurisdiction of the Commissioner.

The statute which the Commissioner contends compels him to issue the patent without delay, 35 U. S. C. § 135, had an exact counterpart in force when the CCPA decided *In re Allen*. Rev. Stat. § 4904, as amended, 53 Stat. 1212 (1939). This statute clearly makes no distinction between the two routes for review, nor does reason suggest why any such distinction should be made.

I would therefore hold that the Commissioner of Patents does not have jurisdiction to issue a patent until after the termination of proceedings brought under 35 U. S. C. § 146.

JUDGMENT OF UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA.

This cause came on to be heard on the record on appeal from the United States District Court for the District of Columbia, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this Court that the judgment of the District Court appealed from in this cause be, and it is hereby, affirmed.

Per Curiam.

Dated: August 27, 1959.

Separate dissenting opinion by Circuit Judge Burger.

MEMORANDUM OF THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLUMBIA.

(Filed Dec. 23, 1958.)

CIVIL ACTION No. 2209-58.

UGO MONACO, *et al.*,
Plaintiffs,

vs.

ROBERT C. WATSON,
Commissioner of Patents,
Defendant.

MEMORANDUM.

The defendant's motion to dismiss is granted.

/s/ EDWARD A. TAMM,
Judge.

Dated: December 23, 1958.

ORDER.

(Filed January 5, 1959.)

This action came on to be heard at this term on motion of defendant, Robert C. Watson Commissioner of Patents, to dismiss the complaint and thereupon, upon consideration thereof, it is this 5th day of January, 1959

ORDERED that the Motion to Dismiss be and it is hereby granted, and that the complaint be and it is hereby dismissed.

/s/ EDWARD A. TAMM,
Judge.

January 2, 1959.

Approved as to form

TOULMIN & TOULMIN,
/s/ By A. H. TOULMIN, JR.,
Attorneys for Plaintiffs.

DECISION OF THE PATENT OFFICE.

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE

Washington

October 17, 1958

INTERFERENCE No. 87,523

HOFFMAN

vs.

MONACO

PETITION

Ugo Monaco petitions the Commissioner "to withhold granting of the patent to Hoffman on the application involved in the above entitled Interference now terminated in the Patent Office but pending appeal in the Federal Courts." In the interference the junior party Hoffman received the award of priority on July 21, 1958. The petition alleges that "applicant Monaco has appealed to the Federal District Court in a suit filed in the District of Columbia, Florida and Connecticut, which is taken from the decision of the Patent Office of the Board of Interferences and which challenges the issues decided by that Board." The petition as filed on August 14, 1958, was not accompanied by a certificate of service but a petition filed August 18, 1958, which appears to be a duplicate of the original petition, contains a certificate of service on Hoffman's attorneys.

Petitioner's reference to a suit in three different District Courts leaves the nature of this suit in some doubt. Assuming, however, that the "appeal" to which petitioner refers consists of three civil actions under 35 U. S. C. 146, the pendency of these civil actions provides no basis for

the relief requested; see section 1109 of the Manual of Patent Examining Procedure (2nd ed., November 1953). It is well established that the Commissioner may not withhold the issuance of a patent to the winning party in an interference merely because of the filing of a civil suit by the losing party. *In re Sargent*, 1877 C. D. 125, 12 O. G. 475; *Wells v. Boyle*, 1888 C. D. 36, 43 O. G. 753; *McIntyre v. Perry*, 1911 C. D. 92, 169 O. G. 943; *Fischer v. Porter*, 1928 C. D. 13, 368 O. G. 493; *Sanford v. Kepner*, 170 Ms. Dec. 515 (Kepner is patent No. 2,487,447); *In re McDonough* (1955), file of patent No. 2,736,323, paper No. 29. That the Patent Act of 1952 made no change of the law which would aid petitioner's position, was pointed out by the decision of the First Assistant Commissioner in *Eckert and Mauchly v. Williams*, Interference No. 85,809, paper No. 65. (Williams now is patent No. 2,817,477.) A comparison of 35 U. S. C. 135 with R. S. 4904 (35 U. S. C., 1946 ed., 52) shows that the present statute states more explicitly than its predecessor the finality of the decision of the interference tribunal of the Patent Office on the question of priority.

The petition, which includes no citation of authorities supporting the petitioner's position, argues that issuance of a patent to the party Hoffman might result in a patent issuing "to the party not entitled thereto," that "applicant is in substantially the same position as if the case had been appealed to the United States Court of Customs and Patent Appeals," and that "the Patent Office rules require that the patent in the United States be issued to the original and first inventor (see Section 102 Paragraph (f))." But 35 U. S. C. 135 provides that the decision of the Board of Patent Interferences, if adverse to the claim of an applicant, "shall constitute the final refusal by the Patent Office

of the claims involved," and that "the Commissioner may issue a patent to the applicant who is adjudged the prior inventor." The possibility always exists that a United States District Court, in a *de novo* action, may authorize the Commissioner to issue a patent to the plaintiff in that action. This possibility does not, however, affect the finality of the decision of the Board of Patent Interferences on priority. The determination of priority is governed by 35 U. S. C. 135 so that 35 U. S. C. 102 (f) provides no absolute requirement of first inventorship apart from 35 U. S. C. 135. This is illustrated by the second paragraph of 35 U. S. C. 135 and by provision in Rule 232 of a motion to dissolve an interference on the ground that the claims in issue are not patentable to another party. It is apparent that the applicant who does not timely copy claims from a patent or whose application claims may be unpatentable because of a prior publication, for instance, may be in fact a "first inventor," in some sense of the term, but this, without more, would not entitle him to an award of priority or make the issue of a patent to another applicant improper.

The circumstance that the pendency of an appeal under 35 U. S. C. 141 on the interference record might provide an occasion for withholding issuance of a patent to a winning party in an interference does not aid petitioner's cause because the propriety of withholding issuance of a patent to the winning party while an appeal is pending is not under consideration. It is noted, however, that the Patent Office has long recognized a distinction between an appeal on the interference record in the Patent Office and an action *de novo* under 35 U. S. C. 146 (or R. S. 4915) in which additional evidence may be adduced.

The petition is accordingly denied.

/S/ Arthur W. Crocker
First Assistant Commissioner

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CONSTITUTIONAL PROVISIONS AND STATUTES.

Constitution, Art. I, § 8, cl. 8.

The congress shall have power . . .

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;

5 U. S. C. § 1009 (d). Relief pending review.

Pending judicial review any agency is authorized, where it finds that justice so requires, to postpone the effective date of any action taken by it. Upon such conditions as may be required and to the extent necessary to prevent irreparable injury, every reviewing court (including every court to which a case may be taken on appeal from or upon application for certiorari or other writ to a reviewing court) is authorized to issue all necessary and

appropriate process to postpone the effective date of any agency action or to preserve status or rights pending conclusion of the review proceedings.

35 U. S. C. § 135. Interferences.

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted. July 19, 1952, c. 950, § 1, 66 Stat. 801.

35 U. S. C. § 141. Appeal to Court of Customs and Patent Appeals.

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent

interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case. July 19, 1952, c. 950, § 1, 66 Stat. 802.

35 U. S. C. § 146. Civil action in case of interference.

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse

parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law. July 19, 1952, c. 950, § 1, 66 Stat. 803.